REMARKS

The following remarks are made in response to the Non-Final Office Action mailed February 14, 2006. Claims 61-120 were rejected. With this Response, claims 61, 74, 88, 105, 106, 113-120 have been amended. Claims 61-120 remain pending in the application and are presented for reconsideration and allowance.

Claim Objections

Claim 105 is objected to for improper antecedent basis. With the Response, claim 105 has been amended to depend from independent claim 88, which is believed to provide the proper antecedent basis for the limitations of claim 105. Accordingly, the Applicant requests withdrawal of the objection to claim 105.

Claims 114-119 are objected to for improperly referring to "the method of claim 113" when claim 113 recites "[a] computer- readable medium." As suggested by the Examiner, each of claims 114-119 have been amended to recite "the computer-readable medium of claim . . ." Accordingly, the Examiner's objection is believed to have been addressed, and withdrawal of the objection to claims 114-119 is respectfully requested.

Claim Rejections under 35 U.S.C. §102

Claims 61-68, 70, 73-80, 85, 87-91, 94-99, 102-103 and 105 are rejected under 35 U.S.C. §102(e) as being anticipated by Fitzgerald, U.S. Patent No. 6,434,533 B1 ("Fitzgerald").

Claims 61-68, 70, 73-80, 85, and 87

Independent claim 61 recites a computerized method for trading information related to commercial companies. The method includes collecting private company information having a confidential data portion and an exchange data portion and transmitting only the exchange data portion to a central location. With this Response, claim 61 has been amended to recite that the confidential data portion "includes confidential identifying information for the private company" and that the exchange data portion "is characterized by an absence of confidential identifying information for the private company." Support for the new features of clam 61 is found for

13

Amendment and Response
Applicant: G. Stephen LeGraw
Serial No.: 09/754,492
Filed: January 4, 2001
Docket No.: S144.101.102
Title: INFORMATION TRADING SYSTEM AND METHOD
_____

example on page 12, lines 18-28 of the originally filed specification. Fitzgerald fails to disclose the new and previously presented features of clam 61.

Fitzgerald fails to teach or otherwise suggest transmitting <u>only</u> the exchange data portion to the central location where both the confidential data portion and the exchange data portion are collected from the user at a first location as recited in claim 61. Fitzgerald relates to a method for the exchange, analysis, and reporting of performance data in businesses with time-dependent inventory (Title). More specifically, on a first day, a plurality of business entities transmit customer performance data to a report center, which processes the data to provide processed performance data. The processed performance data is provided to selected business entities on a second day (See e.g. Abstract). However, all information, including company identifying information, is collected from the customer 600 and sent to the central business 100, more specifically, the user interface 200 of the business 100 (column 6, line 64 – column 7, lines 25; column 9, lines 12-20). Fitzgerald makes no mention or suggestion to collect information that is <u>not</u> transmitted to the central business 100. **Since Fitzgerald teaches that all collected information is sent to central business 100, Fitzgerald fails to teach or otherwise suggest "transmitting <u>only</u> the exchange data portion to a central location" where both the confidential data portion and the exchange data portion are collected.**

In addition, Fitzgerald fails to teach that the transmitted data (i.e., the exchange data portion) is "characterized by an absence of confidential identifying information for the private company" as recited in claim 61. Rather, Fitzgerald specifically teaches transmission of the company identifying information to the central business 100 is evident by the inclusion of company identifying information (e.g., "Radisson Hotel Memphis," "Holiday Inn Crowne Plaza," "Holiday Inn Select," etc.) in column 1 of the report, which is derived from the collected information, as illustrated in Figure 8 (see also column 10, lines 38-40).

These teachings of Fitzgerald make Fitzgerald less commercially viable than the currently claimed innovation. More specifically, businesses will likely be less inclined to use the system of Fitzgerald since they would be disclosing proprietary information about their specific company to their direct competitors. As such, the present invention not only is not taught or disclosed by Fitzgerald, but also provides a marked improvement over Fitzgerald by providing

14

for businesses to anonymously provide information in exchange for the receipt of statistical averages that the business can use as benchmarking data. For at least these reasons, **Fitzgerald fails to teach or otherwise suggest that the data that is transmitted (i.e., the exchange data portion) is "characterized by an absence of confidential identifying information for the private company" as recited in claim 61.**

For at least the above-described reasons, Fitzgerald fails to disclose, much less suggest, the features recited in amended, independent claim 61. Therefore, independent claim 61 is believed to be allowable, and the Applicant respectfully requests the withdrawal of the rejection of claim 61 under 35 U.S.C. §102(e).

Each of claims 62-68, 70, 73-80, 85, and 87 depends from independent claim 61, which as described above is not taught or otherwise suggested by Fitzgerald. Accordingly, dependent claims 62-68, 70, 73-80, 85, and 87 also are not taught or otherwise suggested by the cited references. Therefore, dependent claims 62-68, 70, 73-80, 85, and 87 are believed to be allowable over the cited reference, and the Applicant respectfully requests the rejections under 35 U.S.C. §102(e) be withdrawn.

In addition, at least claim 74 presents additional allowable subject matter. Dependent claim 74, which was amended to correct informalities not related to patentability, recites "the step of receiving a second exchange data portion from a second user; updating the exchange data portion from a second user; and transmitting <u>the output data set</u> to the second user." Fitzgerald fails to teach or otherwise suggest such features. In particular, Fitzgerald discloses preparation of reports specific to each user contributing information. No single report or "output data set" is transmitted to multiple users (i.e., a first user and a second user as recited in claim 74). More specifically, the Market Fair Share Report of Figure 8 lists the user receiving the report first, and the ADR and Occupancy comparison charts of Figures 9A and 9B specifically show how the particular user receiving the report compares to others in the industry. In this manner, all output reports (i.e., output data sets) are tailored for a specific individual user such that the output data sets are immediately comparable and are no single report is sent to multiple users. **Therefore, Fitzgerald fails to disclose receiving separate data exchange portions from a first and second user and transmitting the same output data set to both the first and second user as**

15

recited in claim 74. Accordingly, the features of claim 74 further support the allowance of claim 74.

Claims 88-91, 94-99, 102-103 and 105

Independent claim 88 recites a network business method for providing commercial statistical data via a network. The method includes generating a commercial data record from commercial data information collected from a user, the commercial data record including a confidential subrecord "that identifies the private company" and an exchange subrecord. Only the exchange subrecord is transmitted to the commercial statistical analysis system. The method further includes generating a commercial statistical data set including statistical averages for the industry and being configured to protect an identity of the private company from other users with access to the commercial statistical data set. This new limitation is supported by the original specification in as much as confidential identifying information is not sent to the statistical analysis system (see e.g., page 12, lines 18-28) and, therefore, it cannot be included the commercial statistical data set that is derived therefrom. Since no identifying information is included in the commercial statistical data set, the identity of the private company is inherently protected from other users receiving the statistical data set. Fitzgerald fails to teach or otherwise suggest the features of claim 88 described above.

In particular, Fitzgerald fails to teach or otherwise suggest transmitting only the exchange subrecord to the commercial statistical analysis system where both a confidential subrecord and the exchange subrecord are collected from the user as recited in claim 88. Fitzgerald discloses a method where on a first day, a plurality of business entities transmit customer performance data to a report center, which processes the data to provide processed performance data. The processed performance data is provided to selected business entities on a second day (See e.g. Abstract). However, all information, including company identifying information, is collected from the customer 600 and sent to the central business 100, more particularly to the report generator 400 (column 6, line 64 – column 7, lines 25; column 9, lines 12-20). In fact, Fitzgerald specifically discloses sending company identifying information to the report generator 400 since the result reports are disclosed as including such information (See e.g., Figure 8). Fitzgerald

16

makes no mention or suggestion to collect information that is not sent to the central business

100. **Since Fitzgerald teaches that all collected information is sent to report generator 400,**

Fitzgerald fails to teach or otherwise suggest "transmitting only the exchange subrecord to

the commercial statistical analysis system" where both the confidential subrecord and the

exchange subrecord are collected from a user.

In addition, Fitzgerald fails to teach that the generated "commercial statistical data set is

configured to protect an identity of the private company from other users with access to the

commercial statistical data set" as recited in claim 88. Rather, Fitzgerald specifically teaches

inclusion of the company identifying information (e.g., "Radisson Hotel Memphis," "Holiday

Inn Crowne Plaza," "Holiday Inn Select," etc.) in the reports generated by the report generator

400, in particular in column 1 of Figure 8 (see also column 10, lines 38-40). These teachings of

Fitzgerald make Fitzgerald less commercially viable than the currently claimed innovation.

More specifically, businesses will likely be less inclined to use the system of Fitzgerald since

they would be disclosing proprietary information about their specific company as directly

identified to their competitors. As such, the present invention as recited in claim 88 is not only is

not taught or disclosed by Fitzgerald, but also provides a marked improvement over Fitzgerald

by providing for businesses to protecting the identity of participating private companies such that

the companies can anonymously provide information in exchange for the receipt of statistical

averages for use in benchmarking. Consequently, **Fitzgerald fails to teach or otherwise**

suggest that the generated "commercial statistical data set is configured to protect an

identity of the private company from other users with access to the commercial statistical

data set" as recited in claim 88.

For at least the above-described reasons, Fitzgerald fails to disclose, much less suggest,

the features recited in amended, independent claim 88. Therefore, independent claim 88 is

believed to be allowable, and the Applicant respectfully requests the withdrawal of the rejection

of claim 88 under 35 U.S.C. §102(e).

Each of claims 89-91, 94-99, 102-103 and 105 depends from independent claim 88,

which as described above is not taught or otherwise suggested by Fitzgerald. Accordingly,

dependent claims 89-91, 94-99, 102-103 and 105 also are not taught or otherwise suggested by

17

the cited references. Therefore, dependent claims 89-91, 94-99, 102-103 and 105 are believed

to be allowable over the cited reference, and the Applicant respectfully requests the rejections

under 35 U.S.C. §102(e) be withdrawn.

Claim Rejections under 35 U.S.C. § 103

Claims 69, 71-72, 81-84, 86, 92-93, 100-101, 104 and 106-120 are rejected under 35

U.S.C. 103(a) as being unpatentable over Fitzgerald.

Claims 69, 71-72, 81-84, and 86

Each of claims 69, 71-72, 81-84, and 86 depends from independent claim 61, which as

described above is not taught or otherwise suggested by Fitzgerald. Accordingly, dependent

claims 69, 71-72, 81-84, and 86 also are not taught or otherwise suggested by the cited

references. Therefore, dependent claims 69, 71-72, 81-84, and 86 are believed to be allowable

over the cited reference, and the Applicant respectfully requests the rejections under 35 U.S.C.

§103(a) be withdrawn.

In addition, claims 69, 71-72, 81-84, and 86 each recite additional, patentably distinct

subject matter. For example, claim 71 recites a step of storing the collected confidential data

portion at the first location, which is not disclosed by Fitzgerald as stated on page 11 of the

Office Action. Further, Fitzgerald does not otherwise suggest such a step. Rather, since all

information is sent to and processed by the central business 100, Fitzgerald provides no reason to

store the "collected information" at the first location where the information was originally

collected. In addition, the CPU and associated memory of the user interface referenced in the

Office Action relate to the user interface 200, which is part of the central system 100 accessed by

the consumer via the secure on-line connection (see e.g., Figure 1A; column 4, lines 51-54;

column 5, lines 5-15). With the configuration disclosed in Fitzgerald in mind, since the user

interface is part of the central system 100 the CPU and memory included therein are located at

the central location not at the first location where the information is collected by the user,

Fitzgerald fails to teach or otherwise suggest a step of storing the collected confidential data

portion at the first location. For at least these reasons, claim 71 is believed to present

18

additional patentably distinct subject matter supporting the requested withdrawal of the rejection of claim 71.

In addition, as stated in the Office Action Fitzgerald fails to disclose collecting asset information including public business valuation information (claim 81), private business valuation information (claim 82), portfolio information (claim 83), or capital structure information (84). There is not suggestion to modify the method of Fitzgerald to include such asset information. The mere inference that a reference <u>can</u> be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of such combination (*In re Mills*, 916 F.2d 680, 12 USPQ2d 1430 (Fed. Cir. 1990); *MPEP §2143.01 III*). Fitzgerald is specifically directed to collect information directly from the users that receive the reports and to provide statistics relating to information not available in through public channels, or at least not available through public channels in a timely manner (see e.g., column 2, line 49 – column 3, line 21). Rather, any suggestion or motivation to modify Fitzgerald comes from the present application which is impermissible hindsight and, therefore, is not a valid source of a suggestion to modify the reference for obviousness purposes (*See MPEP* §2143; *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 566, 568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 1971 (Fed. Cir. 1990)). **Accordingly, there is no teaching or suggestion in Fitzgerald to collect "<u>public</u> business valuation information" as recited in claim 81.**

In addition, no matter in what industry the teachings of Fitzgerald are used, Fitzgerald is specifically related to Time Dependent Inventories (TDI) and the management and pricing of the items within those inventories. Therefore, there is no suggestion to collect or benefit in managing TDIs to collect business valuation information as recited in claims 81 and 82, portfolio information as recited in claim 83, or capital structure information as recited in claim 84 since such information does not effect TDI management. Rather, any suggestion to modify the method of Fitzgerald to collect such information comes from the current application which is impermissible hindsight and is not a valid source of a suggestion to modify the reference for obviousness purposes (*See MPEP* §2143; *In re Bond*). For at least these reasons, the features of claims 81-84 further support withdrawal of the rejections of claims 81-84.

19

For similar reasons as described above with respect to claim 81, **Fitzgerald also fails to teach or suggest a step of "collecting public company commercial information from a published public exchange market."** As described above, such information would not be provided on the short timeline desired by Fitzgerald nor would information on the public exchange market be likely to include information that is relevant to management of a TDI. Consequently, the Applicant requests withdrawal of the rejection of claim 81 for at least these additional reasons.

Claims 92-93, 100-101, and 104

Each of claims 92-93, 100-101, and 104 depends from independent claim 88, which as described above is not taught or otherwise suggested by Fitzgerald. Accordingly, dependent claims 92-93, 100-101, and 104   also are not taught or otherwise suggested by the cited references. Therefore, dependent claims 92-93, 100-101, and 104 are believed to be allowable over the cited reference, and Applicant respectfully requests the rejections under 35 U.S.C. §103(a) be withdrawn.

In addition, claims 92-93, 100-101, and 104 each recite additional, patentably distinct subject matter. For example, claim 92 recites "the step of storing the collected information at the location of the user" and is believed to further support allowance of claim 92 for similar reasons as described above with respect to the features of claim 71. Similarly, claims 100 and 101 respectively recite collecting asset information including "public business valuation" and "private business valuation" and are believed to further support allowance of claims 100 and 101 for similar reasons as described above with respect to the features recited in claims 81 and 82. Accordingly, at least claims 92, 100, and 101 further provide reasons supporting the withdrawal of the associated rejections and allowance of claims 92, 100, and 101.

Claims 106-112

Claim 106 relates to a system form trading commercial information via a network including a commercial information exchange system configured to generate a commercial statistical data set from collected information, where "the commercial statistical data set is

20

Amendment and Response
Applicant: G. Stephen LeGraw
Serial No.: 09/754,492
Filed: January 4, 2001
Docket No.: S144.101.102
Title: INFORMATION TRADING SYSTEM AND METHOD

defined by a lack of information identifying the source of the exchange subrecord." Fitzgerald
fails to teach or otherwise suggest such a limitation for similar reasons as described above
with respect to the feature of claim 88 reciting that "the commercial statistical data set is
configured to protect an identity of the private company from other users with access to the
commercial statistical data set." Therefore, claim 106 is believed to be allowable, and the
withdrawal of the rejections of claim 106 under 35 U.S.C. §103(a).

Claims 107-112 each depend from independent claim 106, which as described above is
not taught or otherwise suggested by Fitzgerald. Therefore, claims 107-112 are not taught or
otherwise suggested. Consequently, claims 107-112 are believed to be allowable and the
rejections under 35 U.S.C. §103(a) of claims 107-112 are respectfully requested to be
withdrawn.

Claims 113-119

Independent claim 113 recites a computer readable medium having computer-executable
instructions for performing a method similar to the method recited in claim 88. Therefore, for
similar reasons as described above with respect to claim 88, claim 113 is not believed to be
taught or otherwise suggested by Fitzgerald. Accordingly, claim 113 is believed to be allowable,
and withdrawal of the rejection of claim 113 under 35 U.S.C. §103(a) is respectfully requested.

Claims 114-119 each depend from independent claim 113, which as described above is
not taught or otherwise suggested by Fitzgerald. Therefore, claims 114-119 are also not taught
or otherwise suggested by Fitzgerald. Consequently, claims 114-119 are believed to be
allowable and the rejections under 35 U.S.C. §103(a) of claims 114-119 are respectfully
requested to be withdrawn.

Claim 120

Claim 120 recites a method for trading private company statistical data. The method
recites generating private company data including a "confidential subrecord including
information identifying the private company and an exchange subrecord defined by an absence
of information identifying the private company" and "transmitting only the exchange subrecord
to the statistical analysis system." Such limitations are not taught or otherwise suggested by the

21

suggested by the cited references due to similar rationale as described above with respect to the confidential data portion and the exchange data portion of claim 61, which, in general, are similar to the confidential subrecord and exchange subrecord of claim 120. In addition, for similar reasons as described above with respect to claim 88, Fitzgerald fails to teach or otherwise suggest the commercial statistical data set being "configured to protect an identity of the private company from other users with access to the commercial statistical data set." Moreover, Fitzgerald fails to teach storing the confidential subrecord at the location of the user as recited in claim 120 for similar reasons as described above with respect to claims 88 and 106.

For at least these reasons, Fitzgerald fails to teach or otherwise suggest the limitations of claim 120. Accordingly, claim 120 is believed to be allowable, and the Applicant respectfully requests the withdrawal of the rejection of claim 120 under 35 U.S.C. §103(a).

Summary of Examiner Telephone Interview

On March 21, 2006, Applicant's representatives had a telephone interview with Examiner Timothy M. Harbeck and his supervisor Hyung S. Sough. In that interview, it was discussed that although the prior art has been searched three times and each time the cited references appear to lack disclosure or suggestion of the features recited in many, if not all, of the claims, additional searching would be performed. Applicant also expressed frustration to the Examiners with the length and cost of prosecution, and the number of new searches.

With regard to any additional search performed, Applicant notes, as described above, that Fitzgerald relates to a system for collecting information from users that is not otherwise received in a timely manner from public routes and/or that is never publicly available. Accordingly, Fitzgerald teaches is specifically drawn to collection of otherwise private information and teaches away from receiving information that is otherwise available through public channels since such information is either untimely or not available. Further, Fitzgerald is specifically configured for use in TDI industries where pricing fluctuates on a day-to-day, or at least week-to-week basis rather than in less volatile pricing markets such as real estate.

22

Amendment and Response
Applicant: G. Stephen LeGraw
Serial No.: 09/754,492
Filed: January 4, 2001
Docket No.: S144.101.102
Title: INFORMATION TRADING SYSTEM AND METHOD

CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 61-120 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 61-120 are respectfully requested.

No fees are required under 37 C.F.R. 1.16(b)(c). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 50-0471.

The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

Any inquiry regarding this Amendment and Response should be directed to Steven E. Dicke at Telephone No. (612) 573-2002, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

> **Dicke, Billig & Czaja, PLLC**
> Fifth Street Towers, Suite 2250
> 100 South Fifth Street
> Minneapolis, MN 55402

Respectfully submitted,

G. Stephen LeGraw,

By their attorneys,

DICKE, BILLIG & CZAJA, PLLC
Fifth Street Towers, Suite 2250
100 South Fifth Street
Minneapolis, MN 55402
Telephone: (612) 573-2002
Facsimile: (612) 573-2005

Date: *May 15, 2006*

SED:hsf

Steven G. Dicke

Steven E. Dicke
Reg. No. 38,431

CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper or papers, as described herein, are being transmitted via facsimile to Facsimile No. (571) 273-8300 on this 15th day of May, 2006.

By: *Steven G. Dicke*

23